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10/595,066

01/27/2006

Paul D. Wightman

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EXAMINER

WARD, PAUL V

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

08/29/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com  
LegalDocketing@mmm.com



**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. The compounds and compositions according to claims 1, 7, 11, 13-14, 17-18, 20-21, 24 and 33 of formula I, wherein  $R_A$  and  $R_B$  are independently H, halogen, alkyl, alkenyl, alkoxy, alkythio and  $-N(R_3)_2$ . These are classifiable in class 548, subclass various.
- II. The compounds and compositions according to claims 1, 7, 11, 13-14, 17-18, 20-21, 24 and 33 of formula I, wherein  $R_A$  and  $R_B$  form a fused aryl ring or 5-7-membered ring not containing a heteroatom. These are classifiable in class 548, subclass 358.
- III. The compounds and compositions according to claims 1, 7, 11, 13-14, 17-18, 20-21, 24 and 33 of formula I, wherein  $R_A$  and  $R_B$  form a fused ring that is six-membered heterocyclic ring with one nitrogen. These are classifiable in class 546, subclass 1+.
- IV. The compounds and compositions according to claims 1, 7, 11, 13-14, 17-18, 20-21, 24 and 33 of formula I, wherein  $R_A$  and  $R_B$  form a fused ring that is a sulfur containing heterocyclic rings with no (0) nitrogen ring members. These are classifiable in class 549, subclass 1+.

- V. The compounds and compositions according to claims 1, 7, 11, 13-14, 17-18, 20-21, 24 and 33 of formula I, wherein  $R_A$  and  $R_B$  form a fused ring that is a five-membered heterocyclic ring with a nitrogen ring member. These are classifiable in class 548, subclass 400+.
- VI. The compounds and compositions according to claims 1, 7, 11, 13-14, 17-18, 20-21, 24 and 33 of formula I, wherein  $R_A$  and  $R_B$  form a fused ring that is a 7-membered heterocyclic rings with a nitrogen ring member. These are classifiable in class 540, subclass various.
- VII. The methods of according to claims 25, 28-29 and 34-35, wherein  $R_A$  and  $R_B$  are independently H, halogen, alkyl, alkenyl, alkoxy, alkythio and  $-N(R_3)_2$ . These are classifiable in class 514.
- VIII. The methods of according to claims 25, 28-29 and 34-35, wherein  $R_A$  and  $R_B$  form a fused aryl ring or 5-7-membered ring not containing a heteroatom. These are classifiable in class 514.
- IX. The methods of according to claims 25, 28-29 and 34-35, wherein  $R_A$  and  $R_B$  form a fused ring that is six-membered heterocyclic ring with one nitrogen. These are classifiable in class 514.

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- X. The methods of according to claims 25, 28-29 and 34-35, wherein R<sub>A</sub> and R<sub>B</sub> form a fused ring that is a sulfur containing heterocyclic rings with no (0) nitrogen ring members. These are classifiable in class 514.
- XI. The methods of according to claims 25, 28-29 and 34-35, wherein R<sub>A</sub> and R<sub>B</sub> form a fused ring that is a five-membered heterocyclic ring with a nitrogen ring member. These are classifiable in class 514.
- XII. The methods of according to claims 25, 28-29 and 34-35, wherein R<sub>A</sub> and R<sub>B</sub> form a fused ring that is a 7-membered heterocyclic rings with a nitrogen ring member. These are classifiable in class 514.

The inventions of Groups I-XII are separate and patentably distinct because there is no patentable co-action among them and a reference anticipating or rendering obvious one member will not anticipate or render another obvious.

Inventions of Group I-VI and VII-XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the process for using the product claimed can be practiced with another materially different product, such as imidazo quinoline compounds.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, a search of the six groups designated above would impose an undue burden upon the examiner, and restriction for examination purposes as indicated is proper.

Applicant election should also include **a specifically disclosed species** to be examined for search purposes in the response. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

- (d) the prior art applicable to one invention would not likely be applicable to another invention;

- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or

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employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

### ***Rejoinder Advisory***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

A telephone call was made to Dean Ersfeld on August 11, 2008 to request an oral election to the above restriction requirement, but did not result in an election being made.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0642. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/James O. Wilson/  
Supervisory Patent Examiner, Art Unit 1624**

<div><b><i>Application Number</i></b></div> <div></div>	<b>Application/Control No.</b>	<b>Applicant(s)/Patent under Reexamination</b>	
	10/595,066	WIGHTMAN, PAUL D.	
	<b>Examiner</b>	<b>Art Unit</b>	
	PAUL V. WARD	1624	